

which is what constitutes the trademark.

I see no reason to disagree with the statement of the majority that the "mark" sought to be registered may be characterized as background display. However, it makes little difference whether the marking on the label be called background display or dress of the goods, or, as the examiner described it, a mere "color scheme used by applicant as a carrying device to display the wording." Whichever it is, it is not a trademark. For a design or, for that matter, for any device or mark to be a trademark, it must not only have been adopted with the intention of making it an indication of origin, but it must be recognized by the purchasing public as such.

In *In re Burgess Battery Co.*, 27 CCPA 1297, 112 F.2d 820, 46 USPQ 39, this court held that a design for a label consisting merely of black and white alternating stripes was mere dress and not registrable, although it gave the package "a distinctive external appearance to appellant's goods; that it is such as to distinguish the goods from those of others." This is the standard for a trademark. It is not enough that the goods are distinctive of the appellant's goods, but they must be distinctive of the appellant's goods. This statement is directly applicable to the situation presented by the present case, it being noted that in each case evidence (consisting in the one case of affidavits and in the other of an ex parte survey) was offered to show that the applicant's design had acquired a secondary meaning.<sup>4</sup>

I think that the Burgess Battery case, supra, is still law for this court and that it was not overruled by *In re Swift & Co.*, 42 CCPA 1048, 223 F.2d 950, 106 USPQ 286, (a case which, it is sometimes argued, overruled it). In the Swift case, the court went to some pains to distinguish the case before it from the earlier case, saying, 106 USPQ at 288, "The Burgess Battery case, supra, stands for the proposition that that which is only the attractive dress of an article, although it be distinctive in its appearance and sometimes recognized by purchasers as an indication of origin, does not have, as its primary function, an origin-authenticating purpose, and is hence not a trademark entitled to federal registration under the statute." I

<sup>4</sup> The board held that the poll was "not persuasive that the purchasing public in general associates the label design sought to be registered with applicant as an identifying and distinguishing symbol," a conclusion with which I fully agree. I think it should be recognized that a survey or poll conducted ex parte by an interested party, with no possibility of checking by means of cross examination or other

see no distinction between the Burgess Battery case and the present one, but I can see a possible distinction between those cases and the Swift case in that the label in the last named, with its polka dot pattern, in a decidedly more distinctive design than either of the others.<sup>5</sup>

I do not think that the enactment of the Lanham Act after the Burgess Battery case, but before the Swift case, had anything to do with the latter decision. Although the Lanham Act does not spell out in its definition of the term "trademark", found in Section 45, a requirement that the symbol or device must be such as will be recognized by the purchasing public as a trademark, it is obviously not the intention of the Lanham Act to eliminate such fundamental requirement for trademark significance. The statutory definition, in requiring that the mark be adopted and used by a manufacturer or merchant to identify and to distinguish his goods from others, and most certainly was referring to their identification and distinction in the marketplace by the purchaser, and this could occur only if the purchasing public accepted the mark as an authentication. Certainly the manufacturer does not adopt a mark for the purpose of enabling himself only to identify and distinguish his own goods.

The Lanham Act never intended such a drastic and sweeping change in the law of trademarks as would be caused by the view that acceptance as a trademark by the public is unnecessary. The case of *Burgess Battery Co. v. Marzall*, 101 F.Supp 812, 92 USPQ 90, 91, was decided after the adoption of the Lanham Act, a fact which the court pointed out, saying, "Because the 1946 Act did not give a new meaning to a trademark, the design cannot be considered a trademark now \* \* \*."

The trademark now before the court consists merely of bands of color running around the can with two empty ovals superimposed upon them, the latter being obviously intended as frames for the real trademark, the autograph of the applicant, which in practice always appears upon them, but for which registration is not being asked. I think that the applicant's color scheme "does not have, as its primary function, an origin-authenticating purpose."

<sup>5</sup> Whether, in view of the fact that the court recognized the Burgess design as being distinctive, the cases are really distinguishable on this basis, is not easy to say, but at any rate, it is plain from reading the Swift opinion that the court did not intend to overrule the Burgess Battery case and did not think that it was

(Swift), that its "office \* \* \* is not to point out distinctly the origin or ownership of the articles to which the label is affixed" (Burgess), and that the purchasing public would not accept it as such. Hence, it is not a trademark. I would affirm the board's decision.

## Patent Office Board of Appeals

Ex parte MORTON, LITTLEFIELD,  
AND MECUM

Patent issued July 31, 1962

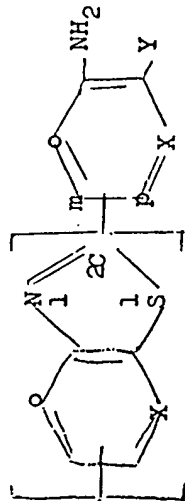
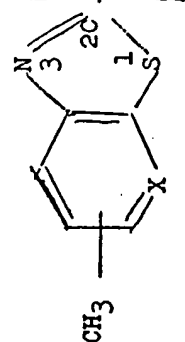
Opinion dated Nov. 28, 1961

## PATENTS

1. Claims — Indefinite — Chemical (§ 20.553)

Specification — Sufficiency of disclosure (§ 62.7)

Fact that specification shows some uncertainty as to whether Y group in formula of claim is —H or —SH is not sufficient to indicate that structure of claimed compound as a whole is based upon speculation; formula set out in claim cannot be held to be based on speculation in absence of some evidence that formula may be in error; mere



n

and wherein:

n is at least 2

H

X is selected from —C= and —N—O, m and p respectively identify ortho, meta and para positions on the ring nuclei

Y is selected from —H and —SH and wherein each of the No. 2 thiazole carbon atoms in the thiazole groups linking the thiazole groups to the ring nuclei is attached to the adjacent ring nucleus at one of the identified ortho, meta and para positions; and wherein not more than about ninety percent of the thiazole carbon attachments are in any one of

absence of infrared spectra analysis does not constitute such evidence; claim is not rejected as indefinite and speculative.

## Particular patents—Resins

3,047,543, Morton, Littlefield, and Mecum, Sulphur-Containing Heat-Resistant Resins, claim 11 of application allowed.

## Appeal from Division 60.

Application for patent of Avery A. Morton, John B. Littlefield, and William D. Mecum, Serial No. 717,307, filed Feb. 25, 1958. From decision rejecting claim 11, applicants appeal (Appeal No. 402-39). Reversed. WALLACE & CANNON and WALLACE, KINZER & DORN, both of Chicago, Ill., for applicants.

Before DUNCOMBE and MACIL, Examiners in Chief, and J. S. BAILEY, Acting Examiner in Chief.

J. S. BAILEY, Acting Examiner in Chief.

This is an appeal from the final rejection of claim 11. Claims 1, 2, 3, 6 and 12, all the claims remaining in the application, have been allowed.

The claim reads as follows:

11. A resin having the formula

the ortho, meta and para positions thereby characterizing the series of said attachments within the resin chain as inclusive of at least two different of the identified ortho, meta and para positions.

No references are relied upon.

[1] Claim 11 has been rejected as failing to comply with 35 U.S.C. 112. The examiner regards the claim as definite and speculative, because, in his opinion the compound is alleged to have a complicated structure, which should have been corroborated as by giving the results of infrared spectrum analysis of the product.

We are of the opinion that this rejection

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tion cannot be sustained. We do not consider the fact that the specification shows some uncertainty as to whether the Y group in the formula of claim 11 is -H or -SH sufficient to indicate that the structure of the compound as a whole is based upon speculation. It is our opinion that the disclosure adequately supports appellants' statement that the resin is made up of cyclic nuclei linked by thiazole groups. It is our view that the formula set out in the rejected claim cannot be held to be based upon speculation in the absence of some evidence that the formula may be in error. We do not believe that the mere absence of infrared spectra analysis constitutes such evidence.

We are also of the opinion that the fact that the claim does not indicate the exact position of the linkages on the cyclic nuclei does not render the claim indefinite for the reasons given by appellants in their briefs. Nor do we consider the claimed structure implausible because it is disclosed that a range of proportions may be employed in preparing the resin. The claim is generic and is intended to cover a number of resins having the structure set out.

The examiner has referred to the fact that a holding that claim 11 is allowable would indicate that the allowance of claim 12, drawn to the product defined in terms of its method of preparation, is improper. That issue is not before us here. The only rejection presented for our consideration is the propriety of the rejection of claim 11. For the reasons given above, we do not consider the rejection proper.

The decision of the examiner is reversed.

#### Patent Office Board of Patent Interferences

ORTHUBER AND STANLEY V. BLACKSTONE, HOWELL, WILLEY, AND DERGANG

Opinion dated Mar. 19, 1962

#### PATENTS

1. Construction of specification and claims—Interference counts—In general (§ 22.501)

Interference count may not have a limitation read into it by interpretation.

2. Construction of specification and

not introduce an ambiguity nor call back to an explicit definition of words in specification, so it must be held to mean what it plainly says.

Particular patents—Journal Boxes 2,856,539, Orthuber and Stanley, Apparatus and Method for Detecting Overheated Journal Boxes, refused priority as to claim 19 against Blackstone, Howell, Willey, and Dergang application.

Patent interference No. 90,150 between Richard K. Orthuber and Charles V. Stanley, Patent No. 2,856,539, issued Oct. 14, 1958, on application filed Jan. 25, 1954, and Henry Blackstone, Sabert N. Howell, Frank G. Willey, and William Dergang, application, Serial No. 675,948, filed Aug. 2, 1957. Priority awarded to Blackstone, Howell, Willey, and Dergang; Boys, Examiner of Interferences, specially concurring with opinion.

C. CORNELL REMSEN, JR., RAYSON P. MORRIS, and MICHAEL EBERT, all of New York, N.Y., for Orthuber and Stanley.

ROY C. HOPGOOD and JOHN M. CAMMAFFE, both of New York, N.Y., for Blackstone, Howell, Willey, and Dergang.

Before WILLNER, LEVIN, and Boys, Examiners of Interferences.

WILLNER, Examiner of Interferences. This interference relates to detecting overheated journal boxes of railway car axles.

The issue of the interference consists of a single count, corresponding to claim 19 of the patent to Orthuber et al., and which is as follows:

The method of determining temperatures above a predetermined value of journal boxes comprising the steps of applying a radiation image of a portion only of a moving journal box to a detector, and utilizing the signal generated by said detector for indicating that the temperature of the journal box is above said predetermined value.

The party Blackstone et al. moved to shift the burden of proof on the basis of an earlier application, Serial No. 349,826 filed April 20, 1953. The motion to shift was granted. The now junior party Orthuber et al. moved to dissolve on the ground that Blackstone et al. has no right to make the count. This motion was denied by the Primary Examiner. The junior party Orthuber et al. has

filed briefs for and appeared at final hearing.

[1] Giving full credit to the "utilizing the signal" clause of the count, that is, that the count requires sufficient time integration of detector excitation to produce a utilizable signal, the count reads literally upon both of the Blackstone et al. application disclosures because, as the examiner stated, only that portion of the journal box, which is "viewable" by a simple single axis optical system is applied to the detector by Blackstone et al. The interpretation put upon the count by Orthuber et al. is as if the count read "applying a portion only of the radiation image of a moving journal box to a detector," and if it could be read thus we do not believe it would properly read upon the Blackstone disclosure. However to alter the count in this fashion is to violate the rule that a count may not have a limitation read into it by interpretation. In re Levy, 1925 C.D. 180. See also Humiston v. Voorhees, 1928 C.D. 83.

[2] We do not know if the language of the count was deliberately chosen to achieve breadth or not, but it does not introduce an ambiguity nor call back to an explicit definition of words in the specification, so it must be held to mean what it plainly says. The count being supportable by the disclosures of the senior party, Blackstone et al. the junior party is not entitled to prevail.

Accordingly, priority of invention of the subject matter in issue is hereby awarded to Henry Blackstone, Sabert N. Howell, Frank G. Willey, and William Dergang, the senior party.

Boys, Examiner of Interferences (specially concurring).

I agree with the majority in the conclusion that both of the Blackstone applications support the count in issue but for a different reason. I do not accept as sound the reasoning of the Primary Examiner, as does in effect the opinion of the majority, that since the optical system of Blackstone et al. can scan only the front and a portion of the bottom of a journal box it satisfies the requirement of the count "applying a radiation image of a portion only of a moving journal box". This view disregards the obvious impossibility of providing means to sense the radiation image of the entire exterior surface of a journal box (including back and top). Constructed in this manner the count would not exclude any optically practical radiation sensitive system arranged to scan moving journal boxes. In my opinion the limitation finds ade-

cation. This portion of the specification suggests that the effective area of the sensing means be narrow in the direction of train movement but extending vertically entirely across the journal box. The expressed purpose of this arrangement is to at least approach equalization of the signal whether the train is moving fast or slowly. The sentence beginning at line 27 of the aforesaid page 7 states:

If the train is moving slowly, then the detector cell 25 may saturate before the axle box has proceeded substantially through the field of view, and the output may appear as at c, for the case of DC-polarization, and at d, for AC-polarization. It will be seen that by making the detector area of elongated narrow shape, as suggested in Fig. 7 at least one is assured of an output magnitude for slow-moving trains approaching than (sic) attainable with the fast-moving trains.

I believe it clear that the reference to saturation in the quoted excerpt indicates that the maximum signal amplitude is reached before the entire box has passed through the field of view of the radiation sensing means and that this signal is used for indicating that the temperature of the journal box is above the predetermined value as required by the count. Substantially the same language appears in the involved application of Blackstone et al. and in my opinion this provides support for the count in issue. It should be noted that the Orthuber et al. patent states in effect that their device would not satisfy the limitation in question at train speeds over fifty miles per hour for box faces of the stated dimensions. It thus appears that so far as satisfying the broad requirement of the count is concerned the only difference between the two disclosures is possibly one of the maximum speed at which the conditions specified in the count will obtain. Since that speed could obviously be varied within wide limits by choice of parameters it is my opinion that the count is supported as well by the Blackstone applications as by the Orthuber et al. patent. See *Hegy v. Albers-Schoenberg v. Geldermans et al.*, 47 CCPA 1135 1960 C.D. 473, 126 USPQ 405, 280 F.2d 859.

In my opinion the above provides a sounder basis for the award of priority to Blackstone et al. in which I concur.

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Minerals can be and achieve purity greater than natural products. The term generally comprehends the metals (ores) fossil fuel, glass, rocks, sulfur, the study and classification, chemical composition, physical, such as color, structure. This term is used to describe a variety of uses are obsolescent,

black pigments  
of blue pigments  
dust, nuisance dust  
carbonate  
petroleum derivative

red  
asphalt  
of naphtha  
spring water containing

in the earth (ozoce-  
petroleum  
made by blowing air or

the term refers to such  
iron, copper, phospho-  
rum, fluorine, and trace

of volume equal to ap-

red oxide of lead.  
Utah, Wisconsin.

monoisopropanolamine.

propyldiamidophospho-

See sweetener,

of alkyd type resins.  
marketed under this  
modifications including  
s, non-drying oils, nat-

finishes including ar-  
tic, hammer, and other

industrial enamels; also printing inks and textile finishes.

**mirbane oil.** See nitrobenzene.

**"Mirrex,"**<sup>482</sup> TM for a calendered, unplasticized PVC film. Available in film or sheeting for a wide range of packaging applications.

**mirror-image molecules.** See optical isomerism, enantiomorph, chiral.

**misch metal.** The primary commercial form of mixed rare-earth metals (95%) prepared by the electrolysis of fused rare earth chloride mixture, d approximately 6.67, mp approximately 648C. Form: waffle-like plates weighing 40-60 lb packed in oiled paper, immersed in oil, or coated with vinyl paint.

**Hazard:** Flammable, dangerous fire risk.

**Use:** Lighter flints, ferrous and non-ferrous alloys, cast iron, aluminum, nickel, magnesium and copper alloys, getter in vacuum tubes, magnetic alloys.

**miscibility.** The ability of a liquid or gas to dissolve uniformly in another liquid or gas. Gases mix with one another in all proportions. This may or may not be true of liquids, whose miscibility properties depend on their chemical nature. Alcohol and water are completely miscible because of their chemical similarity, but some liquids are only partially miscible in others because of their chemical difference, e.g., benzene and water. Many gases are miscible with liquids to a greater or lesser extent, e.g., formaldehyde mixes readily with water; CO<sub>2</sub> is partially miscible with water and oxygen only very slightly. Liquids that do not mix at all are said to be immiscible, as oil and water. The term "solubility" is often used synonymously with "miscibility" in reference to liquids, but it more properly applies to solids.

**Mitchell, Peter.** (1920- ) A British biochemist who was the recipient of the Nobel prize for chemistry in 1978 for his work on studies of cellular energy transfer. A graduate of Cambridge and recipient of many awards, he has been Director of Research, Glynn Research Institute, since 1964.

**miticide.** A pesticide which kills mites, small animals of the spider class, among them the European red mite and the common red spider which infest fruit trees.

**mitochondria.** Particles of cytoplasm found in most respiring cells. They synthesize most of the

cell's adenosine triphosphate and are the chief energy sources of living cells. They are highly plastic, mobile structures which may fragment or fuse together at random. Many enzymes, especially those involved in converting food-derived energy into a form usable by the cell, are located in the mitochondria and DNA molecules have also been found there. Yeast is a particularly rich source of mitochondria for research purposes.

**mitomycin C.** C<sub>15</sub>H<sub>18</sub>N<sub>4</sub>O<sub>5</sub>. Antibiotic derived from Streptomyces, stated to be effective against tumors.

**mitosis.** The division of a cell nucleus to produce two new cells, each having the same chemical and genetic constitution as the parent cell. The deoxyribose (nucleic acid) component of the chromosomes is present in duplicate in the original nucleus. The amount of nucleic acid is doubled just before cell division begins; subsequent events (called phases) permit separation of the products of replication to form the new nuclei. Each half-chromosome carries the identical nucleic acids of the original chromosome.  
See also cell (1).

**Mitsunobu reaction.** Intermolecular dehydration reaction occurring between alcohols and acidic components on treatment with diethyl azodicarboxylate and triphenyl phosphine under mild neutral conditions. The reaction exhibits stereospecificity and regional and functional selectivity.

**mixed acid.** (nitrating acid). A mixture of sulfuric and nitric acids used for nitrating, e.g., in the manufacture of explosives, plastics, etc. Consists of 36% nitric acid and 61% sulfuric acid.  
**Hazard:** Spillage may cause fire or liberate dangerous gas. Causes severe burns, irritant by ingestion and inhalation, may cause NO<sub>x</sub> poisoning.

**mixing.** Effecting a uniform dispersion of liquid, semi-solid or solid ingredients of a mixture by means of mechanical agitation. Low-viscosity liquids and suspensions are mixed with impellers of the turbine or propellor type. The mixing action results both from direct contact of the impeller blades with the liquid and from the turbulence induced by the impeller in the outer portions of the liquid. For this reason the diameter of the impeller need be only from one-fourth to one-half that of the container. For liquids of medium viscosity, revolving paddles of various shapes are used. Thicker mixtures involving volatile solvents are mixed in closed containers (churns) equipped with fin-like members